PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial No.:	10/764,977
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Applicant:	Stanley, et al.
Title:	CUSTOMIZABLE STORAGE AND DISPLAY SYSTEMS
Examiner:	HOGE, Gary Chapman
Art Unit:	3611
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Confirm. No.:	9301

Via EFS Electronic Filing

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Commissioner for Patents
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Alexandria, Virginia 22313-1450

PETITION FILED UNDER 37 C.F.R. §1.181

Dear Director:

Pursuant to 37 C.F.R. §1.181 and as set forth in M.P.E.P. §706.07(c), Applicant respectfully petitions the Director to withdraw the premature FINAL Office Action mailed on October 21, 2008 (the "FINAL Office Action") for at least the following reasons:

The outstanding FINAL Office Action is premature because the Examiner has taken action that is not authorized by any legal authority. In this case, the Examiner ignored Applicant's election of claims and chose what claims would be examined. Consequently, Applicant's elected claims remain unexamined.

Accordingly, an Appeal to the Director is appropriate because the correctness of the Office Action is at issue. *See* 37 C.F.R. 1.181(a).

A. FACTS

In Applicant's response filed 9/17/2007, Applicant elected Group I, Species III, which Applicant concluded were claims 1-11 and 13-17.[1] In the next Office Action, a Final Office Action,[2] the Examiner examined an entirely different set of claims, i.e., claims 8-11 and 13-17 and failed to provide notice as to why these different claims were examined.[3] In fact, the Final Office Action erroneously alleged that Applicant had elected these claims, which further confused Applicant. Applicant responded to the Final Office Action to point out that the wrong claims were examined.[4] In response, the Examiner abandoned the Application.[5]

Applicant telephoned the Examiner and it was during this interview that the Examiner informed Applicant that he had unilaterally decided to further limit the Restriction Requirement and had intentionally examined only claims 8-11 and 13-17 while leaving claims 1-7, and 12 unexamined.[6]

The Examiner argued that 37 CFR 1.142(b) allows the Examiner to pick and choose what claims should be examined.[7] Applicant remarked that the CFR does not permit the Examiner to unilaterally decide what claims should or should not be examined, nor does any portion of the MPEP. Applicant pointed out that the CFR merely states, in sum, that after Applicant elects claims, those claims that are not indicated as "cancelled" by the Applicant, are "withdrawn." and therefore, "not considered by the Examiner."

As applied to the case at hand, Applicant did not elect claim 12. Pursuant to 37 CFR 1.142(b), the Examiner may treat claim 12 as "withdrawn" and, therefore, claim 12 may be "not considered by the Examiner." The MPEP does not, however, allow the Examiner to ignore the

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[1] The Examiner indicated Group I included claims 1-11 and 13-17, and Species III included claims illustrated by Figs. 7-9.

[2] The Examiner issued a FINAL office action after the Restriction Requirement had been issued.

[3] The Examiner stated that "[c]laims 1-7 and 12 are withdrawn from further considered pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species" and that "[e]lection was made without traverse in the reply filed on September 17, 2007." *See* the Office Action, pg. 2, para. 1.

[4] See Applicant's Response to Office Action filed May 20, 2008.

[5] See Notice of Abandonment dated June 2, 2008.

[6] See Applicant summary of interview filed June 9, 2008.

[7] 37 CFR 1.142(b) provides that "[c]laims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled."

claims that Applicant elects, nor does the MPEP allow an Examiner to elect claims. Such conduct, if permissible, would negate the entire purpose of the Restriction Requirement, i.e., to provide Applicant the right to elect an invention for which claims will be restricted.

In apparent acknowledgement that the CFR does not actually state such, the Examiner located a previous version of 37 CFR 1.142(b) and read that prior version of the CFR to Applicant. Applicant noted that even the outdated version does not support the Examiner's unreasonable interpretation and Applicant strongly objected to the Examiner's attempt to bolster his position with an outdated version of the CFR.

B. CONCLUSION

As evidenced by the incredibly convoluted file wrapper of the present application, permitting unauthorized actions result in extreme confusion.

Upon issuance of a Restriction Requirement, Applicant has the undisputed right to select what claims will be restricted, as defined by the groups and/or species provided by the Examiner. Applicant's right to rank and choose between important and less important claims thereby defining the course of the patent application is core to the U.S. Patent system. In this instance, unexamined Claims 1-7 quite possibly recite the most crucial aspects of the application. Applicant elected Claims 1-7, yet the Examiner ignored Applicant's election and illegally proceeded to examine the claims he wanted to examine.

Had the Examiner concluded that Applicant's Response did not adequately respond to the Restriction Requirement, the Examiner's only proper recourse under the MPEP is to deem Applicant's response as "non-responsive" and force Applicant to choose, albeit "with traverse." Applicant was denied both of these rights because the Examiner chose Applicant's claims and then stated that Applicant had elected these claims without traverse.

Accordingly, the FINAL Office Action is premature because Applicant's elected claims have not been examined.

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Respectfully submitted,

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